

## **REMARKS**

### **Claim Status**

Claims 1-16 are currently pending, with claims 1 and 12 being the only independent claims. No new matter has been added. Reconsideration of the application is respectfully requested.

### **Overview of the Office Action**

Claims 12, 15 and 16 stand rejected under 35 U.S. C. §102(e) as anticipated by U.S. Publication No. 2002/0172331 (“*Barker*”). Claims 1, 2, 5-7 and 10 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Barker* in view of U.S. Publication No. 2003/0169865 (“*Oren*”). Claim 3 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Barker* in view of *Oren*, and further in view of U.S. Patent No. 5,313,515 (“*Allen*”). Claim 4 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Barker* in view of *Oren*, and further in view of U.S. Patent No. 6,912,271 (“*Tuttle*”). Claims 8 and 9 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Barker* in view of *Oren*, and further in view of U.S. Publication No. 2005/0212659 (“*Sauer*”). Claim 11 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Barker* in view of *Oren*, and further in view of U.S. Publication No. 2002/0082007 (“*Hoisko*”). Claim 13 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Barker* in view of *Oren*, and further in view of *Allen*. Lastly, claim 14 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Barker* in view of *Oren*, and further in view of *Tuttle*.

Applicants have carefully considered the Examiner’s rejections, and the comments provided in support thereof. For the following reasons, applicants respectfully assert that all claims now pending in the present application are patentable over the cited art.

### **Patentability of Independent Claims 1 and 12 under 35 U.S.C. §102(b)**

Independent claim 1 was previously amended to recite the limitation “wherein said producing of the sound content at the first telephone terminal precedes and is temporally separate from said sending of the sound content by the first telephone terminal, said sound content being included in a message as an element of the message; and wherein said producing of the sound content is performed without requiring connection of the first telephone terminal to a remote device”. Independent claim 12 was previously amended to recite the limitation “said sound content being previously produced at the telephone terminal without requiring connection of the telephone terminal to a remote telecommunications device, and wherein said storage entity extracts the sound content contained in the message”. That is, independent claims 1 and 12 respectively define a method and a device for producing sound content, such as an audio element, at a telephone terminal without requiring connection of the telephone terminal to a distant, remote device. The cited art fails to teach or suggest applicants’ claimed invention.

The Examiner (in *Response to Arguments* at pgs. 2-3 of the Office Action) asserts that:

In page 2, paragraph 0023, page 5, paragraph 0082, Barker discloses that the sender can dictate the message by speaking into a microphone and after completing the message, the message is transmitted to a playback server [i.e., storage entity]. It clearly means that the sound being previously produced at the sender’s terminal without requiring connection of the telephone terminal to a remote telecommunications device. The sender types in the message the desired date and time for delivery of the message (see page 5, paragraph 0079. When the delivery time comes, the server sends the audio message to the recipient. It clearly means that the server extract the sound content from the message. In other word, the storage entity extracts the sound content contained in the message.

Applicants do not agree.

*Barker* (paragraph [0008], lines 1-8) describes “a telephone message delivering system ... which allows a sender to select a pre-recorded track from a menu, to be replayed to the

recipient over the telephone lines. In this way, no new recording need be made. It is not dependent upon the memory capacity and reproduction capacity of a mobile telephone. A message can be sent to an ordinary fixed telephone. Copyright problems due to the creation of new recordings are avoided". *Barker* (paragraph [0008], lines 1-8) further explains "that provision should be made to make an entry in a list to provide a record of the number of times a given track has been played so that any necessary royalty payments can be made to the owners of intellectual property rights". *Barker* thus teaches a system and method in which the primary objective is to provide a way to avoid problems associated with the limited storage capacity of a telephone and problems related to the payment of royalties associated with copyright ownership.

*Barker* (paragraph [0023]) teaches that the disclosed system and method achieves the foregoing objective by allowing a user of a telephone terminal to send to a recipient a message that includes pre-recorded sounds elements, such as music tracks or Christmas greetings, without having to record these elements on his or her telephone; the message is stored on a server and the sender of the sound message is given access to those server-stored sound elements via a simple list on a menu. Thus, the sound elements are not input to or recorded on the telephone; they reside exclusively on the server, and are selected for inclusion in a message through a simple text "pick list" that the user can access on the telephone. Moreover, throughout the entire *Barker* publication, there is no teaching or suggestion that the user can compose a message without being connected to the server from which the message is eventually sent. That is, even assuming, *arguendo*, that *Barker* teaches that a pre-recorded message can be personalized with other elements (i.e., with sound or a written message) by speaking into a microphone (or typing at a computer), and that the complementary sound is composed from the terminal, *Barker* in fact teaches only that the composed sound message is always directly recorded on the server from

which the message is eventually sent. Applicants thus dispute the Examiner's proffered analysis of *Barker*.

*Barker* (paragraph [0076]) clearly explains that the sender of the message dictates the text of their message by speaking after a cue, such as a tone, i.e., the terminal of the sender functions as a microphone. The dictated text is then recorded by a processor unit 141 of the call compilation system 140, which is not part of the telephone but, instead, part of a remote server. This process of *Barker* can only occur while the telephone (or the user's personal computer) is connected to the server.

*Barker* is replete with statements consistent only with this interpretation of its teachings. *Barker* (paragraph [0058], lines 4-6) explains that “[t]he sender's telephone is connected to the public switch telephone network or PSTN (130)”. *Barker* (paragraph [0070], lines 3-6) additionally explains that “the sender will use their telephone 100. The sender will telephone the system 140 using either a premium rate line 110 or a normal rate line 11”. *Barker* thus clearly teaches that the user of the telephone composes sound content while connected to the call compilation system 140 via a telephone link. *Barker* (paragraph [0079], lines 1-4) further explains that “[i]n order to initiate the process the sender will send a request for instructions via their personal computer 200, over a premium rate line 210 or normal rate line 211, via the internet 230 to the server 240”. *Barker* thus teaches that in instances where the sender utilizes a computer instead of a telephone terminal, dictation of text is also performed while the computer terminal of the user is connected to a server on which the sound content dictated by the user is directly recorded.

*Barker* accordingly teaches two embodiments in which sound content is placed, i.e., recorded, on a server. That is, *Barker* teaches two different ways to record sound content dictated by a user directly on a remote device, both of which are consistent with its described

objects, i.e., avoiding the storage of messages on the terminal prior to sending the message to a recipient.

*Barker* (paragraph [0083], lines 2-8) provides still additional teachings that evidence and support the fact of connection of the telephone/terminal to the remote server while a user dictates a message. *Barker* (paragraph [0083], lines 2-8) states that “the sender will contact the system by telephoning or logging on to the call compilation server 240 via a premium rate line.... As soon as connection is made to the compilation server 140 or 240, a timer ... will commence timing the duration of the call”. *Barker* (paragraph [0083], lines 10-22) also explains that “[a]ll the time that the call compilation procedure is being executed, the processor will continue to time the sender's call ... the processor will compute the time required for the sender to remain connected via the premium rate line to the compilation server 140 or 240”. Such continuous connections and tariff charging for connection times is contrary to and defeats the central purpose of the claimed invention, i.e., avoiding charges associated with call connections.

*Barker* thus clearly teaches a system and method that is in direct opposition to applicants' invention as recited in independent claims 1 and 12; the claimed invention permits the composition of sound content without the need to connect the input telephone or personal computer to a remote device, such as a telecommunications network. *Barker* clearly teaches a system and method in which a sender, when connected to a server, composes a message with sound content that is directly recorded on the server. *Barker* simply fails to teach or suggest the recited subject matter of independent claims 1 and 12.

Moreover, even assuming, *arguendo*, that the server of the *Barker* system is capable of receiving information relating to the sending of the message (i.e., the telephone number of the recipient, the date and hour for delivery), this information is not extracted from the message itself but is, instead recorded independently – in sequential order, one after the other – and directly on the

remote system 140 or server 240, as described in steps S7 to S9, S29 to S31 in FIGS. 9 and 10 of *Barker*.

The instant claimed invention differs from the teachings of *Barker* in that the produced sound is only included in a message when sound content including the message is sent. As a result, a telephone terminal is only required to access the telephone network for a short period of time to effect actual transmission of the previously produced sound content. *Barker* fails to teach or suggest applicants' claimed invention that encompasses these advantageous features and functionality.

Reconsideration and withdrawal of the rejection of independent claims 1 and 12 as anticipated by *Barker* under 35 U.S.C. §102 are accordingly deemed to be in order, and early notice to that effect is solicited.

Moreover, by virtue of the above-discussed differences between the recitations of independent claims 1 and 12 and the teachings of *Barker*, and the lack of any clear motivation for modifying the reference teachings to achieve applicants' claimed invention, independent claims 1 and 12 are likewise deemed to be patentable over *Barker* under 35 U.S.C. §103.

#### **Patentability of Independent Claim 1 over the Prior art Under 35 U.S.C. §103**

The Examiner (at pg. 6 of the Office Action) acknowledges that *Barker* fails to teach or suggest "storing said sound content with a view to subsequent consultation by a second telephone terminal," as recited in independent claim 1, and cites *Oren* for this feature.

Applicants, however, contend that no combination of *Barker* and *Oren* achieves the subject matter of independent claim 1. There is simply nothing in *Oren* to cure the above-discussed deficiencies in *Barker*, e.g., the lack of teachings relating to applicants' claimed

producing of the sound content that is performed without requiring connection of the telephone terminal to a remote/telecommunications device.

*Oren* discloses “a method, apparatus and system of completing a call when a called party has not answered the call from a calling party” (see Abstract). *Oren* (paragraph [0005], lines ) explains that an interaction between the parties is completed, rather than simply the completion of a voice call. *Oren* (paragraph [0005], lines 9-12 ) further explains that “a network operator’s central office may reallocate ‘circuit switching’ and voice channels for other context, while reducing real-time voice interaction constraints within the network”. *Oren* (paragraph [0005], lines 12-14) additionally explains that “messaging content generated by the present invention is transmitted in less expensive ‘data circuit’ channels, such as the Internet”.

There is nothing in *Oren* to cure the above-discussed deficiency in *Barker*, e.g., the lack of teachings relating to applicants’ claimed producing of the sound content that is performed without requiring connection of the telephone terminal to a remote/telecommunications device.

In view of the foregoing, independent claim 1 is deemed to be patentable over the combination of *Barker* and *Oren*. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) are requested, and early notice to that effect is earnestly solicited.

#### **Patentability of Dependent Claims 3, 4, 9, 11, 13 and 14 Under 35 U.S.C. §103**

The Examiner (at pgs. 8 and 12 of the Office Action) acknowledges that *Barker* and *Oren* fail to teach or suggest depositing the message in a telephone user’s voice mailbox as recited in dependent claims 3 and 13, and cites *Allen* for this feature.

The Examiner (at pgs. 9 and 12 of the Office Action) also acknowledges that *Barker* and *Oren* fail to teach or suggest “an entity for sending a voicemail greeting for a voice mailbox as

the voicemail greeting of that mailbox” as recited in dependent claims 4 and 14, and cites *Tuttle* for this feature.

The Examiner (at pg. 10 of the Office Action) also acknowledges that the combination of *Barker* and *Oren* fails to teach or suggest “the elements comprising the coordinates of the at least one recipient contains the coordinates of a plurality of recipients”, as recited in dependent claims 8 and 9, and cites *Sauer* for this feature.

The Examiner (at pg. 11 of the Office Action) also acknowledges that the combination of *Barker* and *Oren* fails to teach or suggest “the elements comprising the coordinates of the at least one recipient contains the coordinates of a plurality of recipients”, as recited in dependent claim 11, and cites *Hoisko* for this feature.

Applicants, however, contend that no combination of *Baker*, *Allen*, *Tuttle*, *Sauer* and/or *Hoisko* achieves the subject matter of independent claim 1, from which each of claims 3, 4, 9 and 11 variously depend and/or the subject matter of independent claim 12, from which dependent claims 13 and 14 depend. There is simply nothing in *Allen*, *Tuttle*, *Sauer* or *Hoisko* to cure the above-discussed deficiencies in *Barker* and *Oren*, e.g., the lack of teachings relating to applicants’ claimed producing of the sound content that is performed without requiring connection of the telephone terminal to a remote/telecommunications device.

*Allen* discloses a system in which a call is diverted to a voice messaging center so that the caller can record a voice message upon failure to connect to a desired telephone. *Allen* further teaches that when such a failure occurs, the messaging center transmits a “message waiting” signal to the desired recipient telephone when it registers with a cell of the network (see col. 1, lines 40-64). *Allen* expressly explains that the voice message is recorded while the caller is connected to the telephone network. Therefore, *Allen* fails to teach or suggest producing of the sound content without connection of the telephone terminal to a remote/telecommunications

device. Moreover, *Allen* teaches that the sound content (a voice message) is produced by the caller directly at the voice messaging center. Independent claim 1, moreover, recites the step of “producing the sound content and sending said sound content by a first telephone terminal..., said sound content being included in a message as an element of the message”. *Allen* also fails to teach or suggest this limitation.

*Tuttle* discloses an automated method for delivering a recorded personalized information message via an automated dialing system onto answering machines without performing any truncations (see Abstract and col. 2, lines 44-48). The *Tuttle* method does not provide anything whatsoever with respect to producing sound content by a telephone terminal in the manner disclosed and claimed by applicants herein.

*Sauer* discloses a method for using a wireless communications device to automatically send a recorded message to a group of recipients (see paragraph [0008]). According to *Sauer*, “a broadcast circuit in a wireless communications device [accepts] recorded messages, recipient lists, and broadcast option selections. Then, the device automatically, for example, with a single key stroke, supplies the message to the recipients via an airlink interface”. *Hoisko* discloses “a method and system in which the content and intelligibility of communication by telephone are improved by means of music” (see Abstract).

*Sauer* and *Hoisko* do not provide anything whatsoever with respect to producing sound content by a telephone terminal in the manner disclosed and claimed by applicants herein.

Each of the cited references thus fails to teach or suggest the express recitations of applicants’ independent claims 1 and 12. Since *Baker*, *Allen*, *Tuttle*, *Sauer* and *Hoisko*, individually or in combination, fail to teach or suggest the features recited in independent claims 1 and 12, dependent claims 3, 4, 9, 11, 13 and 14 are deemed to be patentable based at least on their various dependencies from claims 1 and 12.

### **Dependent Claims**

In view of the patentability of independent claims 1 and 12 for the reasons presented above, each of dependent claims 2-11 and 13-16 is respectfully deemed to be patentable therewith over the prior art. Moreover, each of these claims includes features which serve to still further distinguish the claimed invention over the applied art.

### **Conclusion**

Based on all of the above, applicants submit that the present application is now in full and proper condition for allowance. Prompt and favorable action to this effect, and early passage of the application to issue, are once more solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate an early resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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